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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,088	06/19/2001	Peter Jan Leonard Mario Quaedflieg	24615-20145	9816

25225 7590 08/09/2004  
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EXAMINER

SHIAO, REI TSANG

ART UNIT PAPER NUMBER

1626

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/869,088

Applicant(s)

QUAEDFLIEG ET AL.

Examiner

Robert Shiao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on application filed on -6/19, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-19 are pending in the application.

#### ***Election/Restrictions***

2. This application contains the following inventions or groups of inventions, which are not so linked as to form a single inventive concept under PCT Rule 13.1.

- I Claims 1, in part, and 6-11, drawn to process of making a compound of formula (1) of claim 1, wherein the variable  $R_1$ ,  $R_2$ , X, and Y are as defined in claim 1 except: variable  $R_1$ ,  $R_2$ , X, and Y do not represent heteroary or heterocycle (i.e., imidazole, indole),  $R_1$ ,  $R_2$ , X, and Y are not substituted with heteroary or heterocycle (i.e., imidazole, indole) thereof; If this group is elected, applicants are requested to elect a single species for the search purpose.
- II Claims 1, in part, 4-5, drawn to process of making a compound of formula (1) of claim 1, wherein the variable  $R_1$ ,  $R_2$ , X, and Y are as defined in claim 1 except: variable  $R_1$ ,  $R_2$ , X, and Y do not represent heteroary or heterocycle (i.e., imidazole, indole),  $R_1$ ,  $R_2$ , X, and Y are not substituted with heteroary or heterocycle (i.e., imidazole, indole) thereof; If this group is elected, applicants are requested to elect a single species for the search purpose.

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- III      Claims 2-3, in part, 14-19, drawn to process of making a compound of formula (2) of claim 2, wherein the variable  $R_1$ ,  $R_2$ , X, and Y are as defined in claim 1 except: variable  $R_1$ ,  $R_2$ , X, and Y do not represent heteroary or heterocycle (i.e., imidazole, indole),  $R_1$ ,  $R_2$ , X, and Y are not substituted with heteroary or heterocycle (i.e., imidazole, indole) thereof; If this group is elected, applicants are requested to elect a single species for the search purpose.
- IV      Claims 2-3, in part, 12-13, drawn to process of making a compound of formula (2) of claim 2, wherein the variable  $R_1$ ,  $R_2$ , X, and Y are as defined in claim 1 except: variable  $R_1$ ,  $R_2$ , X, and Y do not represent heteroary or heterocycle (i.e., imidazole, indole),  $R_1$ ,  $R_2$ , X, and Y are not substituted with heteroary or heterocycle (i.e., imidazole, indole) thereof; If this group is elected, applicants are requested to elect a single species for the search purpose.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhaustive, as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same.

The claims herein lack unity of invention under PCT rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compound claimed contain aryl (i.e., phenyl) or alkyl moiety, which does not define a contribution over the prior art, as can be seen by the compounds of US 5,612,474, see CAS: 126:277722. The substituents on the phenyl moiety vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unit of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, and the complications in understanding the claimed subject matter impose a burden on any examination of the claimed subject matter.

3. Applicants are advised that the reply to this requirement to be complete must include an election of invention to be examined even though the requirement be traversed (37 CFR 1.143).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

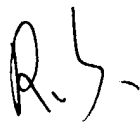
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***Telephone Inquiry***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert Shiao, Ph.D.  
Patent Examiner  
Art Unit 1626

  
for Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626

8/5/04

August 5, 2004